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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,621	07/25/2006	Hubert Moriceau	9905-37 (BIFI16044/US)	2319
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EXAMINER				
PATEL, REEMA				
ART UNIT		PAPER NUMBER		
2812				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,621

Applicant(s)

MORICEAU ET AL.

Examiner

REEMA PATEL

Art Unit

2812

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-8 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/11/09 and 10/29/09 has been entered.

Specification

2. The amendment filed 10/29/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figure 7 of the Drawings illustrates removal of the sacrificial layer (3) to expose the roughened plate surface (2). However, there is insufficient support for this amendment to the drawings.

3. In the Remarks (9/11/09), the Applicant states that the new Fig. 7 is supported by Substitute Specification, pg. 15, lines 8-32 and pg. 16, lines 1-10 which discloses that the plate "surface can be exposed by selective processing of the sacrificial layer" (Remarks, page 10). Firstly, these selective passages mostly talk about the previous Fig. 7, where a surface layer 6 is formed on a plate 1. This seems largely irrelevant in relation to the new Fig. 7 (10/29/09 amendment) because this involves a sacrificial layer (labeled as "3") on a plate 1.

4. The amendment to the Specification (10/29/09) modifies the paragraph on page 16, beginning at line 26 to discuss [the new] Figure 7. The Examiner does not find this passage supportive of the new Figure 7 in terms of introducing a non-continuous sacrificial layer which exposes part of a roughened surface of the first plate.
5. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 5-8, and 11-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
8. Claim 1, amended 11/19/08, still contains the limitation that the sacrificial layer is partly eliminated to "expose the surface portion such that the surface portion at least partially faces the second plate." As applicants point out in page 6 of the Remarks (11/18/08), the applicants' Specification discloses:

"a portion of the intermediate sacrificial layer between the two plates may be eliminated, for example, to obtain two facing surfaces at least one of which is appropriately structured. This prevents the two surfaces sticking together following movement of the two substrates toward each other." (Substitute Specification, p 7, lines 20-25).

9. While this excerpt provides support for at least partially eliminating the sacrificial layer so that the plates face each other, there is no section in this excerpt or anywhere else in the Written Description or drawings that discloses the surface portion (roughened side of first plate) is exposed. In a semiconductor fabrication context, an "exposed" structure or layer is usually open to the air or other environment. In the instant invention, Figure 4 illustrates partially eliminating the sacrificial layer but does not disclose that the surface portion of the first plate is in any way exposed since there is a layer of sacrificial layer over the entire surface portion of the first plate. Claims 5-8 and 11-26 inherit the 35 U.S.C. 112 rejection based on their dependency on claim 1.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al. (U.S. 6,156,215; "Shimada").
12. Claim 26 is a product-by-process claim and as such, will be examined in accordance with the structural limitations implied by the method steps in claim 1, the method claim upon which it depends (MPEP 2113).
13. Regarding claim 26, Shimada discloses in Figures 1A-1F, a first plate (1) with a surface portion (3) having a roughness such that the surface portion is incapable of sticking to a surface of a second plate (8), wherein the surface portion of the first plate is

exposed and at least partially faces and is in close proximity to the second plate (Fig. 1E). Method claim 1 includes forming a sacrificial layer and at least partly eliminating the sacrificial layer. Hence, if this sacrificial layer is entirely removed, then there is no sacrificial in the final stacked structure.

Response to Arguments

14. Applicant's arguments filed 9/11/09 and 10/29/09 have been fully considered but they are not persuasive.

15. Regarding the claims 1, 5-8, and 11-26 rejection, Applicant argues that the term "faces" in claim 1 necessarily means that the roughened portion of the first plate is opposite to the second plate with no intervening structures between the surfaces of the plates. The Examiner disagrees with this narrow interpretation of the word "face" and in the course of the broadest reasonable interpretation, interprets the word "face" to mean overlap but not necessarily with the limitation that there are no intervening layers.

16. Applicant attempts to support the narrow definition of the word "face" by referencing the Specification (Remarks, pg. 7) and particularly Figures 3 and 4. Examiner agrees that these figures disclose the sacrificial layer (3) but feels that they do not adequately support Applicant's definition of "faces" to indicate no intervening structures. Figures 3 and 4 do not even illustrate a second plate (5) and as such, they cannot disclose the surfaces and the second plates facing each other. Applicant further points to a passages in the (Substitute) Specification (pg. 7, lines 20-25) which indicates that the two plates have "facing surfaces" but this by itself does not offer support that "facing" in this context implies no intervening structures in between.

17. Applicant further asserts that one skilled in the art would understand "facing" to mean with no intervening structures in between based on the plain and ordinary meaning of the word "face" in Webster's Third New International Dictionary (Remarks, pg. 8). Applicant indicates the word 'face' is defined as "to stand or sit opposite to" and the word 'opposite' is defined as "set over or against something that is at the other end or side of an intervening line or space." (Remarks, pg. 8). The Examiner still does not find adequate support since something can be set over or on the other side of another thing with intervening materials in between.

18. Applicant asserts that they disclose processes in which at least a portion of the sacrificial layer (3) is removed (Remarks, page 8). The Examiner does not dispute this general premise but does not find that removal of at least a portion of sacrificial layer necessarily implies "exposing a portion of the rough surface of the underlying plate" (Remarks, page 8).

19. Regarding the claim 26 rejection, since the Examiner interprets the term "face" from claim 1 to not imply no intervening layers in between, the reference Shimada et al. used in rejection of this product-by-process claim does not require partially removing a peeling layer (4, Fig. 1E) or light blocking layer (5, Fig. 1E).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REEMA PATEL whose telephone number is (571)270-1436. The examiner can normally be reached on M-F, 8:00-4:30 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Garber can be reached on (571)272-2194. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter L. Lindsay, Jr./
Primary Examiner, Art Unit 2812

/R. P./
Examiner, Art Unit 2812
12/31/09